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In re Application of
Brzustowicz et al.
Application No.: 10/564,260
PCT No.: PCT/US01/13107
Int. Filing Date: 23 April 2001
Priority Date: 21 April 2000
Attorney Docket No.: 1594-RUT.00-0084PCTA
For: Methods And Compositions For
The Diagnosis Of Schizophrenia

DECISION

ON

PETITION

This is in response to the renewed petitions to revive under 37 CFR 1.137(b) filed on 27 September 2006 and 04 December 2006.

DISCUSSION

In a Decision mailed on 02 October 2006, the petition filed on 12 July 2006 was dismissed without prejudice because

Applicants state the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. However, it is unclear from the supporting information, whether that is correct. By January 2005, applicants were aware of the abandonment of this application. However, the first petition to revive was not filed until 10 January 2006. Applicants indicate that they were under the belief that the application could not be revived. This appears to be intentional delay. See MPEP 711.03(c)(II)(D). Further, the original declaration of the inventors indicated that they were made aware of the abandonment of this application in January 2005. In her more recent declaration, Ms. Bassett claims that she only became aware of the abandonment of the application in November 2005, contradicting her earlier declaration.

The declaration of Vincent Smeraglia is inadequate. It is clear that counsel was directed to abandon this application and 16 others. Mr. Smeraglia claims this instruction was a clerical error, but applicants do not indicate that they have attempted to revive the other 16.

The intentions of Ms. Brzustowicz with regard to the abandonment of this application are not relevant as she was under an obligation to assign her invention to Rutgers. Rutgers owned the invention and abandoned it. Ms. Bassett claims that she was a co-owner of this invention with Rutgers and was not under an obligation to assign. If this is correct, it is unclear why she is not listed as an applicant for any state other than the United States. Further, if Ms. Bassett gave control of the prosecution of this application to Rutgers, Rutgers' decision to abandon the application is binding on Ms. Bassett. See MPEP 711.03(c)(II)(E).

In response, counsel argues in part that "Dr. Bassett was not informed of the abandonment until sometime in November of 2005." However, this argument does not in itself resolve the discrepancy between Dr. Bassett's statements; i.e., whether she became aware of the abandonment in January 2005 or November 2005. Resolution of this issue calls for the submission of statement(s) by individual(s) having first-hand knowledge of the facts involved, directly addressing this discrepancy and explaining when in fact Dr. Bassett became aware of the abandonment.

As to the declaration of Vincent Smeraglia, petitioner appears to have provided a copy of Mr. Smeraglia's earlier declaration, which has been considered previously. It is noted that Mr. Smeraglia appears to suggest that the inventors were notified in January 2005 (para. 4).

Petitioner's arguments in general appear to address two basic issues: (1) whether the abandonment of this application was unintentional with regard to the actions and inactions on the part of Rutgers, and (2) whether Dr. Bassett should be bound by the actions or inactions on the part of Rutgers.

Addressing issue (1), petitioner states that the instant international application, along with "an additional 17 PCT applications" (not the 16 stated previously) were "caused... to be filed" by Rutgers and that this application became abandoned as the result of counsel being directed by Rutgers to "allow all Brzustowicz applications to lapse." Counsel suggests that the delay in prosecuting this application was unintentional, since it was not intended to be included among the applications to be abandoned. The relevant inquiry in determining whether a delay is intentional is whether the course of action resulting in the delay was, deliberate. See In re Maldaque, 10 USPQ2d 1477 (Comm'r Pat. 1988); In re Application of G, 11 USPQ2d 1378 (Comm'r Pat. 1989); Lawman Armor v. Simon, 2005 U.S. Dist. Lexis 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005). A deliberate decision, not to pursue further prosecution warrants the conclusion that the abandonment of this application was not unintentional. Lawman, *supra*. Where the delay results from a deliberate cause of action (or inaction), it cannot be considered unintentional delay. Maldaque, *supra*; G, *supra*; Lawman, *supra*; Field Hybrids, *supra*.

Petitioner has not adduced an adequate showing that the abandonment of this application did not arise from a deliberately chosen course of action (i.e., the decision to "allow all Brzustowicz applications to lapse."). Specifically, counsel has not furnished adequate evidence backing up the assertion that the instant application was not intended to be included among those to be deliberately abandoned (e.g., copies of correspondence between Rutgers, the inventors and counsel, as appropriate, showing the deliberative process underlying the delay at issue, and specifically showing whether this particular application was intended to be grouped with the others). Where documentary evidence of this nature is unavailable, counsel should furnish signed statements by individuals having first-hand knowledge of the facts being asserted, describing in detail how this application came to be included among the set of "all Brzustowicz applications" which were to be allowed "to lapse," and whether the resultant delay in prosecuting this particular case was in fact unintentional. It is noted that petitioner has provided a copy of an email to Kate Rigaut, dated 01 November 2005, which references a "CAPON case" and requests that counsel "let us do some digging around and give you an update." However, it is not clear from the text of the email itself that it refers specifically to the present application. Moreover, petitioner has not produced documentary evidence of the fruits (if any) of the "digging around" suggested by the email. Furthermore, this email is dated 3 years after the date of abandonment, and does not shed any light on the intent of applicant at the time of abandonment.

Regarding issue (2), petitioner argues that "the facts as they relate to Anne S. Bassett clearly indicate that as to her, this application was unintentionally abandoned." In support of this position, counsel indicates *inter alia* that "she did not 'give control of the prosecution' to Rutgers," that "Dr. Bassett did not assign her rights in the invention to Rutgers, nor was she under an obligation to do so," that "she had no reason to believe that all efforts to keep this application in force would not be taken," and that "There was no legal agreement between Rutgers and Anne S. Bassett..." Dr. Bassett states herself that "It was my understanding and belief that, on my behalf, Rutgers has been active in pursuing patent prosecution of the '13107 application in the U.S." Based on these statements, it appears that Dr. Bassett did not herself retain counsel to prosecute the application, that Dr. Bassett did not enter into an agreement with a third party (Rutgers) to prosecute the application, and that counsel for Rutgers owed her no fiduciary duty with respect to the prosecution of this application. Counsel's attention is respectfully drawn to MPEP 711.03(c)(II)(E), which indicates in relevant part that

Likewise, where the applicant permits a third party (whether a partial assignee, licensee, or other party) to control the prosecution of an application, the third party's decision whether or not to file a reply to avoid abandonment is binding on the applicant. See *Winkler*, 221 F. Supp. at 552, 138 USPQ at 667. Where an applicant enters an agreement with a third party for the third party to take control of the prosecution of an application, the applicant will be considered to have given the third party the right and authority to prosecute the application to avoid abandonment (or not prosecute), unless, by the express terms of the contract between applicant and the third party, the third party is conducting the prosecution of the application for the applicant solely in a fiduciary capacity. See *Futures Technology Ltd. v. Quigg*, 684 F. Supp. 430, 431, 7 USPQ2d 1588, 1589 (E.D. Va. 1988). Otherwise, the applicant will be considered to have given the third party unbridled discretion to prosecute (or not prosecute) the application to avoid abandonment, and will be bound by the actions or inactions of such third party

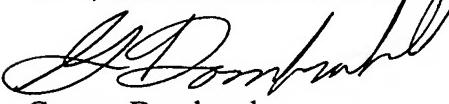
Here, based on petitioner's assertions, it appears that Dr. Bassett abdicated the prosecution of this application, rather than taking an active role in the prosecution. As such, it appears that she permitted Rutgers to control the prosecution of the application and, if this is correct, Rutgers' apparent decision to abandon the application is binding on her. Thus, based on the evidence currently of record, it would not be appropriate to accept petitioner's position that "the facts as they relate to Anne S. Bassett clearly indicate that as to her, this application was unintentionally abandoned."

DECISION

The petition under 37 CFR 1.137(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this matter is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are available.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, P.O. Box 1450, Mail Stop PCT, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.



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